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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			RUMP, RICHARD M	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OLEG STENZEL, STEFAN UHRLANDT,
HANS-DETLEF LUGINSLAND, and ANDRE WEHMEIER

Appeal 2010-000219
Application 10/523,029
Technology Center 1700

Decided: June 30, 2010

Before CHARLES F. WARREN, CATHERINE Q. TIMM, and
STEPHEN WALSH, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision to reject claims 1-4 and 21-28. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

Appellants' invention relates to highly dispersible precipitated silica which has a high surface area, and is used as a tire filler for commercial vehicles, motorbikes, and high speed vehicles (Spec. 1:2-7). Claim 1 is illustrative:

Claim 1. A precipitated silica, wherein said silica has the following properties:

BET surface area	190 - 302 m ² /g,
CTAB surface area	≥ 170 m ² /g,
DBP number	200 - 300 g/(100 g), and
Sears number V ₂	10-20 ml/(5 g).

The Examiner maintains, and Appellants seek review of, the following rejections:

1. Claims 1-4 and 21-28 rejected under 35 U.S.C. 103(a) as being unpatentable over Uhrlandt et al (U.S. Patent No. 6,180,076 B1, issued Jan. 30, 2001); and
2. Claims 1-4 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 13 of Uhrlandt.

II. DISPOSITIVE ISSUE

Has the Examiner adequately reviewed Appellants' showing of unexpected results?

We answer this question in the negative.

III. DISCUSSION

A. OBVIOUSNESS REJECTION

The Examiner's rejection is based upon the finding that Uhrlandt describes a precipitated silica with properties overlapping or lying within the claimed ranges (Ans. 7). This, according to the Examiner, is sufficient to establish a *prima facie* case of obviousness (Ans. 8).

Appellants respond with two declarations (First Wehmeier Dec., filed June 20, 2008 and Second Wehmeier Dec., filed Jan. 15, 2009). According to Appellants, these Declarations provide evidence of unexpected results (Br. 5-7). Specifically, these Declarations report on the high-temperature tear resistance of tire treads containing the precipitated silica as a filler as measured by the Die C test according to ASTM D 624 (1st and 2nd Decs.). Appellants explain the significance of the data in the Brief (Br. 5-6 (higher values of Die C, the greater the high-temperature tear resistance; *see also* 1st Dec. ¶ 8 and 2nd Dec. ¶¶ 9, and 11). Appellants further indicate that Example 4 of Uhrlandt is the closest prior art to the invention (2nd Dec. ¶ 6), and that the inventive examples provide data for silica across the claimed ranges with a trend showing significant improvements across those ranges (2nd Dec. ¶¶ 5, 9, and 12; Br. 6).

Rather than evaluating the data, the Examiner responds by stating that the claims are directed to silica, rather than tires; that the intended use of the silica carries no patentable weight; and that the examples of Uhrlandt cannot be compared to the instant invention because none of the examples of Uhrlandt have all the parameters within the instantly claimed ranges (Ans. 10-11).

We determine that the Examiner has erred by not properly evaluating Appellants' declaratory evidence. The Examiner is essentially requiring Appellants to compare their invention with itself. That is improper. The fact of the matter is that Uhrlandt describes a range of precipitated silica products and Appellants claim another range of precipitated silica products that merely overlap with those of Uhrlandt. Under those circumstances, evidence showing that the unexpected result occurs throughout the claimed compositions as compared to a prior art example representing the closest prior art is deemed sufficient under the law to support a showing of unexpected results. *See In re Peterson*, 315 F.3d 1325, 1330 (Fed. Cir. 2003) (an applicant may overcome a prima facie case of obviousness by showing that the claimed range achieves unexpected results relative to the prior art range throughout the entire claimed range); *In re Hill*, 284 F.2d 955, 958-59 (CCPA 1960) (The showing must also present enough data points within the prior art range, but outside the claimed range, to establish that the unexpected property does not occur outside the claimed range); and *In re Baxter Travenol Labs*, 952 F.2d 388, 392 (Fed. Cir. 1991) (The "difference in results" must be established as being between the claimed subject matter and the closest prior art.). The Examiner did not make the sort of review required to determine whether the showing of unexpected results was adequate when the evidence was viewed as a whole to overcome the prima facie case of obviousness.

B. NON-STATUTORY DOUBLE PATENTING

In determining that claims 1-4 are not patentably distinct from claims 1 and 13 of Uhrlandt, the Examiner merely points out that the precipitated silica of Uhrlandt's claims 1 and 13 have physical and chemical properties

overlapping those of appealed claims 1-4 (Ans. 4-5; Ans. 12). The Examiner again includes no analysis of the showing of unexpected results.

With regard to the non-statutory double patenting rejection, the relevant question is: Is the subject matter of the claim an obvious variation of an invention claimed in the Uhrlandt patent? To answer this question, one must determine the differences between the claimed genus of silicas and the patented genus of silicas and then determine whether the differences render the claimed invention patentably distinct. Here the difference is the difference in silica structure and morphology as shown by differences in property ranges and Appellants have presented evidence showing that the claimed silicas are non-obvious in comparison to the prior art silicas because results within the claimed range are unexpected rather than predictable. Therefore, it was incumbent upon the Examiner to review and properly evaluate the evidence to determine whether the silica of the claims is an obvious variation of the silica of Uhrlandts' claims. This the Examiner did not do.

IV. CONCLUSION

On the record before us, we do not sustain the rejections maintained by the Examiner.

V. DECISION

The decision of the Examiner is REVERSED.

REVERSED

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